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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/467,706	12/20/1999	PAT CONDON	DC-01916(163	2712
27683	7590	12/22/2005	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			RETТА, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 12/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/467,706

Applicant(s)

CONDON ET AL.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,12-16 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,12-16 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed September 26, 2005. Applicant amended claim 1. Claims 1, 4, 12-16 and 19 are currently pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites "The method of claim 11", however claim 11 is canceled. Correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 12-16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dharnipragada (US 6,490,493) in view of Kroening, further in view of Knowles et al. (US 6,182,897).

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Dharnipragada teaches a method comprising: manufacturer providing a manufacturer's interface (user computer 10), a manufacturer office unit and a manufacturer plant (see col. 3 lines 13-14); passing elements of the main order to a control unit, controlling manufacturing and supply lines containing plurality of hardware and software components (see col. 8 line 63 to col. 9 line 10); customer entering a special configuration details in the computer (see col. 5 line 1 to col. 6 line 19), passing the order to modification unit (col. 5, lines 50-67); checking the special configuration details for compatibility with a main order (col. 5, lines 5-25); passing the order to a modification unit and then to a validation unit (col. 5, lines 5-25); making configuration details available to a control unit (col. 9, lines 1-15); detecting modification flag and obtaining corresponding configuration details (col. 4, lines 10-30, col. 5, lines 30-50); checking configuration details with a database to determine implementation (col. 7, lines 1-63).

Dharnipragada teaches logging modifications as they are made (built database see col. 6 lines 47-65). Dharnipragada teaches during the technology selection, the software will provide a variety of recommendations such as selecting a different product or configuration to meet the process requirements and validation checks, etc., (see col. 8 lines 44-62). Kroening teaches the image builder goes through the baseline image file by file and identifies those areas that are different and determines what parts are to be replaced. Further Kroening teaches the image builder determines changes to be made in registry settings and in interrupt settings so that the new software configuration will operate properly on the computing system and if the desired software configuration is not compatible with the hardware of the computer system then the image builder rejects the bill of material as a non-functional configurations (see col. 5 lines 17-35 and col. 7 lines 22-40). It is known in the art to utilize systems comprising a database that

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maintains a list of compatible components and required testing procedures for the associated components that may be performed during installation to more efficiently produce build to order computer systems. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for manufacturers, as in Kroening and Dharnipragada, to make sure the supply lines contain a plurality of compatible hardware and selected software components for installation into the computer being manufactured in order to install hardware and software that have compatibility with components included within the computer being manufactured for the purpose of having a system that operates correctly and is free of malfunctioning components.

Kroening teaches manufacturing a computer system and entering appropriate data including details into the computer being manufactured (abstract, summary). It would have been obvious to one having ordinary skill in the art at the time of the invention to have adopted the system of Dharnipragada for manufacturing a computer as in Kroening since Dharnipragada is not limited as to the type of manufacture (col. 9, lines 40-60) and since Kroening would have benefited from the guidance, verification and ordering of Dharnipragada in simplification of specification of the computer and management of the built computers.

Knowles teaches providing a manufacturer web page for entering orders and passing the web page order to manufacturer unit or plant (see abstract, summary, col. 3 line 65 to col. 4 line 6, lines 36-50). It would have been obvious to one having ordinary skill in the art at the time of the invention to provide a web page for sending the order of Dharnipragada since a web page provides easy access to different page with the site, such as credit card transaction or tracking progress of the order via the web site maintained by the manufacturer.

Response to Arguments

Applicant's arguments filed August 22, 2005 have been fully considered but they are not persuasive. Applicant argues that there is no basis in the art form combining the references to support since none of the references teach or even suggest the desirability of the combination. Applicant argues that the Dharnipragada reference is directed to building measurement instruments and valves in a "build-to-order" and the Kroening reference is directed to creating and delivering software and the Knowles reference is directed to a web-enabled system and designing and manufacturing of scanners. Examiner disagrees. As stated before in the previous office action motivation does not have to come from the prior art only. Motivation can be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. If applicant is implying that the arts are nonanalogous, it has been held that a prior art reference must either be in the field of applicant's endeavor (manufacturing) or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned (web enabled build-to-order), in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, manufacturers of computer would rely on the system and method used by other manufacturers of build to order products. And one ordinary skill in the art at the time of the invention would use a web enabled ordering system as taught in Knowles for designing, constructing and delivering custom-configured product.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


McIntyre US 6,178,546 teaches making software product deliverables includes reading a description file having description of items to be built, packaged and/or installed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YR


YEHDEGA RETTA
PRIMARY EXAMINER